

Serial No. 10/634,992  
Attorney Docket No. 103864.139US1

### REMARKS/ARGUMENTS

#### **I. Summary of the Office Action**

In the Office Action claims 1-92 are pending and claims 24-29 and 52-71 are withdrawn. Claims 1-23, 30-51, and 72-92 are rejected. In the Office Action, claims 1, 17-18, 30, 35, 37, 50, 76, 81, 86, 87 and 92 have been amended, claims 24-29 and 52-71 have been cancelled without prejudice or disclaimer, and new claims 93-97 have been added. Thus, claims 1-23, 30-57 and 72-97 are pending in the application.

The Examiner rejected claims 1-3, 7-8, 10-16, 19-20, 30-32, 34, 37-39, 43, 45-49, 73-75, 78-80, 83-85, 87, and 89-91 under 35 U.S.C. 102(e) as being anticipated by Hoffman U.S. Patent 4,988,255 (hereinafter "Hoffman"). The Examiner rejected claims 4-6, 33, 44, 72, 77, 82, and 88-89 under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of McGrath *et al.* U.S. Patent 6,494,017 (hereinafter "McGrath"). The Examiner rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of Blaimschein U.S. Patent 5,318,420 (hereinafter "Blaimschein"). The Examiner rejected 17-18, 35, 50, 76, 81, 86, and 92 under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of Kitamura *et al.* U.S. Patent 5,423,216 (hereinafter "Kitamura"). The Examiner rejected claims 21-23, 36, and 51 under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of Yuyama *et al.* U.S. Patent 6,644,504 (hereinafter "Yuyama"). The Examiner rejected claims 40-42 under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of Coughlin U.S. Patent Application 2004/0059463 (hereinafter "Coughlin").

#### **II. Summary of Applicants Reply**

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Applicants respectfully submit that no new matter has been introduced into the subject application. Amendments to and cancellations of the claims are being made solely to expedite prosecution, and do not constitute acquiescence to any of the Examiner's objections to or rejections of the claims. Specifically, the amendment to independent claims 1, 30, 37, and 87 and dependent claims 17-18, 35, 50, 76, 81, 86, and 92 are supported by the original specification and drawings, for example, as discussed below in greater detail. Further, new claims 93-97 are supported by the original specification and drawings, for example, as discussed below in greater detail.

The Examiner's rejections are respectfully traversed below.

Reconsideration of the present application is respectfully requested.

### III. The rejection of Claims under 102(e) and 103(a)

#### A. Rejections Under Hoffman

In rejecting all claims the Examiner relied on Hoffman. Applicants' invention refers to an automated system for emptying contents of a pharmaceutical container wherein the pharmaceutical container is cut allowing the contents to empty. Unlike the claimed invention, Hoffman merely discloses "an unpackaging machine that removes the cap, [ruptures the] seal, [removes the] cotton wad and tablets from a package container." (Hoffman, abstract.)

Applicants have amended independent claims 1, 30, 37, and 87 to better define the patent utility. For example, as amended, claim 1 recites:

An automated system for emptying contents of pharmaceutical containers including medications, comprising:  
a gripper unit for receiving and holding a pharmaceutical container;  
a cutter for cutting at least one of the top, sidewall, and bottom of the pharmaceutical container; and

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a rotating unit operable with said gripper unit that rotates at least a portion of said gripper unit to empty the contents of the pharmaceutical container.

The Examiner stated that "Hoffman discloses . . . a cutter for cutting the pharmaceutical container (47, 48, fig. 5)." (Office Action, page 2.) Applicant respectfully disagrees that Hoffman discloses, at least, for example:

**a cutter for cutting at least one of the top, sidewall, and bottom of the pharmaceutical container**

Rather, Hoffman merely discloses:

After the cap 7 has been removed from the sealed container 6, the control unit 90 then causes the turntable 2 to move the sealed container 6 along the stationary support shelf 12 to the seal rupturing station 38. The seal rupturing station 38 comprises a cup-shaped chuck 41 threaded onto a shaft 43 of a further Pick and Place actuator 42. As shown in FIG. 5, a circular knife 47 having a plurality of extended knife edges 48. . . After the sealed container 6 is aligned properly with the chuck 41, the shaft 43 of the actuator 42 is extended toward the sealed container 6 to a position where the plurality of extended knife edges 48 perforate a seal 52 contained within the container neck 53. . . The actuator 42 then withdraws the chuck 41 from around the container neck 53 leaving the cut seal 52 contained therein. (Col. 4, lines 17- Col. 5, line 15.)

The actuator 42 thereafter rotates the chuck 41 through 90 degrees which results in a circular cut being made in the seal 52, which is usually of a thin foil material. (Col. 6, lines 57-60.)

That is, unlike a cutter for cutting at least one of the top, sidewall, and bottom the pharmaceutical container, Hoffman merely discloses a "seal rupturing station . . . where the plurality of extended knife edges 48 perforate a seal 52 contained within the container neck." Further, Hoffman recites that the seal 52 is "a thin foil material." That is, the seal is not the container, but, rather is merely a thin foil attached to the container. Hoffman acknowledges this difference stating "means for rupturing the seal on the sealed container." (Col. 2, lines 10-15.)

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Further, Hoffman acknowledges that the seal is not the container in the background section when referring to U.S. Pat. No. 4,573,872. There, Hoffman recites: "however, [the 4,573,872] apparatus has the drawbacks that the bottle or vessel is destroyed." (Hoffman, background.) That is, Hoffman's apparatus is intended to not destroy the bottle, but, rather to perforate the seal attached to the bottle. Accordingly, nowhere does Hoffman teach or suggest cutting the pharmaceutical container, rather Hoffman merely ruptures the seal on the sealed container.

Applicants also respectfully submit that claims 2-23, 31-36, 38-51, 72-86, 77-86, and 88-92, each of which depends on independent claims 1, 30, 37, and 87, are allowable for at least the same reasons that the corresponding independent claims 1, 30, 37, and 87 are allowable.

Further, in rejecting claims 12-13, 34, and 47-48, depending from independent claims 1, 30, and 37, the Examiner stated that "Hoffman discloses to place the cut portion in a waste repository (see col. 5, lines 38-53)." (Office Action, page 3.) Applicant respectfully disagrees that Hoffman discloses: a first position to receive the cut portion of the pharmaceutical container, and a second position to place the cut portion in a waste repository. Rather, Hoffman merely discloses a "cotton wad and seal receptacle." (Col. 5, lines 35-37.) As stated previously, similar to the cotton wad, the seal is not the container. Rather, the seal is merely a "thin foil" attached to the container.

Further, claims 13 and 48 recite that the "arm utilizes a vacuum that retains the cut portion." In rejecting claims 13 and 48 the Examiner cited col. 5, lines 38-53. Applicant respectfully disagrees as nowhere does Hoffman disclose a vacuum. Rather, in the cited sections Hoffman merely discloses:

The cotton wad 63 and the cut seal 52 fall from the back screen 73 onto the bottom grid 78 where, in response to the control unit 90 activating a

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not shown valve, air is jetted out of a second blower pipe 81 to propel the cut seal 52 and the cotton wad 63 toward the second sidewall 77 and out through the opening 82 into a not shown waste receptacle, such as a bag provided beneath the opening 82.

Unlike the claimed vacuum that retains the cut portion of the pharmaceutical container, Hoffman merely jets air to propel the seal and the cotton wad. Again, neither of the seal or the cotton wad are the pharmaceutical container. Further, the vacuum applies negative pressure to the pharmaceutical container while the air jet applies positive pressure to the seal and cotton wad.

#### B. Rejection Under Hoffman In View Of Kitamura

In rejecting claims 17, 18, 35, 50, and 92, which depend from claims 1, 30, 37, and 87, the Examiner relied on a combination of Hoffman and Kitamura. While the Examiner admitted that: Hoffman does not include a sensor system to determine when the contents of the container are no longer being emptied, the Examiner stated that:

Kitamura et al. teaches sensor system (7, fig. 4; comprises a light emitter, see col. 6, lines 67-68; col. 7, lines 1-2) to determine the contents of funnel (4, fig. 4) are no longer being emptied to activate the scrapper assembly (8, fig. 4). (Office Action, Page 6)

Applicants respectfully disagree that Kitamura is analogous art. MPEP 2141.01(a) recites:

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

The claimed invention refers to an automated system for emptying contents of a pharmaceutical container. Kitamura refers to "an apparatus which permits continuous automatic determination of the bulk specific gravity of a powdery sample and highly precise measurements thereof." (Abstract) Kitamura's apparatus for determining the bulk

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specific gravity of a sample is nonanalogous to an automated system for emptying contents of a pharmaceutical container. For example, nowhere does Kitamura disclose pharmaceuticals, drugs, a pharmaceutical container, or cutting a container. Accordingly, Kitamura is nonanalogous art.

Without acquiescence to the Examiners usage of Hoffman in view of Kitamura, applicant further contends that Kitamura's sensor does not teach or suggest the claimed invention reciting:

a light beam unit for verifying that the contents emptied directly from the pharmaceutical container.

Rather, for example, Kitamura recites:

The tip of the arm rotates to turn the sample container 2 upside down and to thus drop the powdery sample 1 present in the container 2 into the funnel 4 . . . after the sample-detection sensor 7 detects or confirms whether the powdery sample is completely dropped from the funnel 4 at this state (step 304), a scraping bar-driving unit 8a is put in operation (step 305) so that a scraping bar 8 slides on the upper face of the constant volume receiver 6.

That is, unlike the claimed invention wherein the light source measures the contents exiting directly from the pharmaceutical container, in Kitamura the powder is dropped from a container into a funnel and only after the contents exit the funnel are measurements taken.

Applicants further respectfully submit that claims 17, 18, 35, 50, and 92, which depend from claims 1, 30, 37, and 87, are allowable for at least the same reasons that the corresponding independent claims 1, 30, 37, and 87 are allowable and for at least the aforementioned reasons.

#### V. New Claim

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Applicants respectfully submit new claims 93-97. Further applicants submit that no new subject matter is added by these claims as they are supported by the application. For example, new claims 94-97 are depicted in, at least, figures 9a-9j.

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### **CONCLUSION**

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

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Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

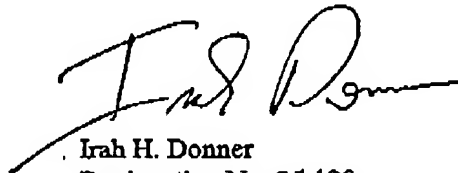
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**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,



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